



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/259,658 02/26/99 COLYER

J 04256/79245

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HM12/0919

EXAMINER

PORTNER, V

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

09/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.

09/259,658

Applicant(s)

Colyer

Examiner

Portner

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 15, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attached response.

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
the proposed claim amendments raise new issues and have not been entered.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: none
Claim(s) objected to: none
Claim(s) rejected: 1-18 and 20
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: See attached interview summary.

LFS
LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

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Claims 1-18 and 20 are pending.

Response to Amendment

1. The Amendment submitted After Final, dated August 15, 2001 proposes amending claims 1, 8, 14 and 17.

a. Claim 1 is proposed to recite the use of a combination of reagents, where the claims now pending recite the use of either one or another reagents. The combination of reagents has not been previously considered on the record and raises a new issue that requires further consideration and/or search.

b. Claim 1 also is proposed to recite additional limitations directed to recited intended use for detecting the presence of a modifying enzyme. The claims examined and finally rejected are directed to a method of analyzing a sample, through assaying a modification of at least one polypeptide through the binding of a binding partner and a first polypeptide. The proposed claim amendments submitted After Final seeks to define the assay to be only that detects a covalent modification due to the presence of a modifying enzyme in the sample. The now claimed invention assays the modification of at least one of the polypeptides, and not the presence or absence of a modifying enzyme. This raises a new issue that requires further consideration and/or search.

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c. While the pending claims recite the step of contacting either the first polypeptide or the binding partner polypeptide with a sample, the nature and contents of the sample are not recited in the claims, thus the changes to the preamble submitted After Final, propose the analysis of a sample for the presence of a modifying enzyme. These proposed claim limitations raise a new issue that would require further consideration and/or search.

The now pending claims define two specific reagents, first and second polypeptides one of which is a binding partner. The proposed amendment of the preamble would define the presence of an enzyme in the sample being analysed, the assay method would then comprise first, second and third reagents. An assay that comprises this configuration of specific reagents has not been previously considered.

d. Claim 17 is proposed to change the recitation of the “modification” to “covalent modification”, wherein the “covalent” modification is required for that association for first and second polypeptides. The examined claims recite a wherein statement that does not require the modification to be a covalent modification, but can be any modification of one of the polypeptides. The proposed amendment of the claims raises a new issue that would require further consideration and/or search.

In view of the proposed claim amendments raising new issues, the Amendment submitted August 15, 2001, will not be entered.

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Response to Arguments

2. Applicant's arguments filed with respect to the proposed claim amendments and the applied prior art have been fully considered but they are not persuasive because Applicant's arguments are directed to the proposed claim amendments which raise new issue, and have not been entered. Applicant's arguments are not commensurate in scope with the instantly claimed invention.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

September 12, 2001